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EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON MA 02205

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OFFICE OF PETITIONS

In re Application of :
Baldwin, et al. :
Application No. 10/082,004 :
Filed: 22 February, 2002 :
Attorney Docket No.70257/40535RE-C :

ON PETITION

This is a decision on the request to ascertain status under ¶(a) of 37 C.F.R. §1.47, filed on 22 February and supplemented on 18 July, 2002.

The Office regrets the delay in addressing this matter, however, the petition was received by the attorneys in the Office of Petitions only at this writing.

The request of 37 C.F.R. §1.47,¹ is **GRANTED**.²

¹ The regulations at 37 C.F.R. §1.47 provide:

§1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

The record reflects that:

- Petitioner in the parent Application No. 08/692,060, of which this is a continuation, evidenced that while inventor Baldwin, Cha, and Suh signed the oath/declaration, the non-signing inventor Chul B. Park (Mr. Park) failed to join in the filing of the above-identified application after having been presented with the application papers;
- specifically, the declaration/statement/submission of facts of/by George W. Neuner (Reg. No. 26,964), Timothy J. Oyer (Reg. No. 36,628) and averred assignee employee Kelvin T. Okomoto establishes that the non-signing inventor was presented the application papers, including the specification, claims and drawings, but failed to respond positively to the request that he sign the declaration or in fact sign said declaration;
- Petitioner submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and petitioner has shown that such action is necessary to prevent irreparable damage; and
- on that basis status was accorded therein under 37 C.F.R. §1.47(a) on 23 January, 1997.

This application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

Pursuant to the commentary at MPEP §201.06(c), because:

- the non-signing inventor previously was forwarded at the address given therein of Notice of the parent application's filing; and

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

² The commentary at MPEP §201.06(c) provides in pertinent part:

New continuation or divisional applications filed under 37 C.F.R. 1.53(b) which contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 C.F.R. 1.47 status in the prior application, should be forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions before being forwarded to the Technology Center (TC). The Office of Petitions will mail applicant a letter stating that "Rule 47" status has been accorded to the continuation or divisional application, but will not repeat the notice to the nonsigning

inventor nor the announcement in the *Official Gazette*. See 37 C.F.R. 1.47(c).

- Notice of the filing also was published in the Official Gazette,
there will be no further notice or publication thereof.

This file is being returned to Technology Center 1700 for processing as necessary to reflect the instant decision.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's/Caller's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.